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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/121,596 07/24/98 MAYAUD

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LM02/1012

EXAMINER

CRECCA, M

ART UNIT

PAPER NUMBER

2765

DATE MAILED:

10/12/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/121,596

Applicant(s)

MAYAUD, CHRISTIAN

Examiner

Michele S. Crecca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 1998.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 70-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 24 July 1998 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____.

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DETAILED ACTION

Pre-Amendments

1. The preliminary amendments have been entered. Claims 1-69 have been cancelled and claims 1-33 have been added. Claims 1-33 have been re-numbered to claims 70-102.

Drawings

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on July 24, 1998 have been approved.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
4. A substitute specification including claims is required pursuant to 37 CFR 1.125(a) because the current copy of the specification has been altered several times due to applicant's amendments and is difficult to read.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 70-78, 80-87, 89-91, 93-96, and 98-102 are rejected under 35 U.S.C. 102(e) as being anticipated by Schrier et al. (US 5,833,599).

Claims 70 and 99: Schrier et al. teaches “a computerized prescription system” (abstract and figure 11) comprising:

“at least one user computer...having a graphical user interface” (col. 5, lines 24-26 and col. 36, lines 22-25 (claim 42));

“permitting capture of prescription information” (col. 4, lines 36-50);

“providing access to one or more of (1) information about a patient’s prescription history” (col. 13, lines 43-48);

“(2) pharmaceuticals arranged by medical conditions...(3) information about the properties of pharmaceuticals” (col. 9, lines 38-46 and fig. 6).

Regarding claim 99 which claims the “computer program product” for the system of claim 70, this claim is rejected per the arguments for claim 70.

Claim 71: the computerized prescription system in which “...said user computer may communicate with one or more other computers” (col. 5, lines 21-23).

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Claim 72: the computerized prescription system in which one or more of the computers includes "at least one of (1) a Health Maintenance Organization, (2) a hospital...and (7) a physician practice" (col. 5, lines 18-20).

Claim 73: the computerized prescription system in which "said user computer is configured to gather information from more than one of said one or more computers and present that information to a user upon request...through said graphical user interface" (col. 3, lines 41-48).

Claim 74: the computerized prescription system in which "user computer is configured to gather information from more than one of said one or more computers and compile that information into a prescription history for a patient" (col. 13, lines 43-48 and fig. 11, reference 312 "previous orders").

Claim 75: the computerized prescription system in which "user computer is configured to gather information ...and compile that information into said information about pharmaceuticals" (col. 5, line 14 "drug-specific knowledge bases" and col. 29, lines 50-62).

Claim 76: the computerized prescription system in which "user computer is configured to gather information...and compile that information into said information about the properties of pharmaceuticals" (col. 23, line 61).

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Claim 77: the computerized prescription system in which "said graphical user interface permits a user to send a prescription directly to a pharmacy to be filled over said communications medium" (col. 14, lines 65-67 and fig. 11, reference 318).

Claim 78: the computerized prescription system in which "information about pharmaceuticals is selectively arranged in at least two of (1) order of frequency with which pharmaceuticals are prescribed, (2) alphabetical order, (3) order of condition treated and (4) in order of pharmaceuticals prescribed for a particular patient" (col. 35, line 47 "...additional drugs suitable for the clinical condition..." and col. 5, lines 59-62).

Claim 80: the computerized prescription system in which "...pharmaceuticals are selectively arranged by drug category" (col. 5, lines 62-67).

Claims 81 and 82: the computerized prescription system in which "the graphical user information will suggest an alternative pharmaceutical" and the "use of said alternative pharmaceutical may be retrieved" (col. 30, lines 33-38 (claim 3)).

Claim 83: the computerized prescription system in which "...a patient's prescription history is arranged by condition" (col. 5, lines 47-52).

Claims 85 and 100: Schrier et al. teaches "a computer implemented method of creating prescription" (fig. 11) comprising the steps of:

"capturing prescription information" (col. 4, lines 36-50);

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"formatting said prescription information" (col. 13, line 6 – col. 15, line 9); and

"sending said prescription information to a pharmacy" (col. 14, lines 65-67).

Regarding claim 100 which claims the "computer program product" for the system of claim 85, this claim is rejected per the arguments for claim 85.

Claim 86: the computer implemented method in which "said prescription information includes the condition to be treated by the prescribed item" (fig. 15, note "Dosage and Recommendation" portion where "(condition)" is inserted).

Claim 87: the computer implemented method in which "the prescription information is selected from a predefined list" (col. 5, line 59).

Claim 89: the computer implemented method in which "said predefined list is arranged in order of cost" (col. 11, lines 30-47 and fig. 9).

Claim 90: the computer implemented method in which "said predefined list is arranged in order of therapeutic preference" (col. 5, line 60).

Claims 91 and 101: Schrier et al. teaches "a method of compiling a patient record" (col. 5, lines 47-49) comprising:

"interrogating databases expected to contain information about a patient based on a patient's relationship with the provider of the database" (col. 6, lines 26-31); and

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"assembling patient information into a chronologically current version of said patient's medical history" (col. 6, lines 4-11).

Regarding claim 101 which claims the "computer program product" for the system of claim 91, this claim is rejected per the arguments for claim 91.

Claim 93: the system of claim 70 in which "information about a patient's prescription history, information about pharmaceuticals arranged by medical condition...or information about the properties of pharmaceuticals is arranged based on the identity of a user" (col. 35, lines 42-54 (claim 35)).

Claims 94 and 102: Schrier et al. teaches "a computerized prescription system" (abstract and fig. 11) comprising:

"a graphical user interface" (col. 5, lines 24-26 and col. 36, lines 22-25 (claim 42));

"capture of prescription information" (col. 4, lines 36-50);

"and providing access to one or more of (1) information about a patient's medical history, (2) information about therapeutic agents and (3) information about individual prescriber activity" (col. 3, lines 59-61 and col. 5, lines 47-49).

Regarding claim 102 which claims the "computer program product: for the system of claim 94, this claim is rejected per the arguments for claim 94.

Claims 95 and 96: the system in which information on an individual prescriber (person who prescribed said prescription) is stored (col. 21, line 41 "ID of physician").

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 84 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schrier et al., as applied to claim 70 above, and in view of Ballantyne et al. (US 5,867,821).

Schrier et al. teaches a "computerized prescription system" (abstract and fig. 11) which can be implemented on a "variety of hardware and software platforms..." (col. 3, lines 52-57). However, Schrier et al. does not specifically recite the use of a "personal digital assistant" as an option for implementing the computerized prescription system. Ballantyne et al. teaches a method and system for accessing and distributing medical services in clinical settings (i.e. hospitals) and off-site locations (i.e. homes). Ballantyne et al. shows the use of personal digital assistants (PDAs) in the delivery of medical services because the compact size of the PDA makes it the tool of preference for mobile medical personnel. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to use the PDA of Ballantyne et al. in the computerized prescription system of Schrier et al. in order to gain the advantage of staff mobility while maintaining access to data files and the ability to prescribe treatments and medications in the presence of the patient.

9. Claims 79, 88, 92, and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schrier et al.

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Claim 79: Schrier et al. teaches "a computerized prescription system" in which pharmaceuticals are arranged in lists and categories (col. 5, lines 53-67). However, Schrier et al. does not specifically recite that the "...pharmaceuticals are arranged by the body system treated by the pharmaceuticals." Official Notice is taken that categorizing pharmaceuticals by "body system" is old and well-known in the medical arts. The ability of a practitioner to access pharmaceuticals by body system provides a logical route for determining and selecting appropriate pharmaceuticals for a particular body system ailment. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include categorizing pharmaceuticals by body system in order to gain the above advantage.

Claim 88: Schrier et al. teaches "a computer implemented method for creating a prescription" in which pharmaceuticals are arranged in lists and categories (col. 5, lines 53-67). However, Schreir et al. does not specifically recite the computer implemented method in which "said predefined list is arranged in order of frequency of prescription for a specified condition." Official Notice is taken that listing pharmaceuticals in order of frequency of use for a type of condition is old and well-known in the medical arts. It is well accepted that some types of pharmaceuticals are more appropriate for certain conditions than other types of pharmaceuticals therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to use "frequency of prescription" as a ranking factor in listing pharmaceuticals for prescription for a certain type of condition.

Claim 92: Schrier et al. teaches a "method of compiling a patient record" (col. 5, lines 47-49), however, Schrier et al. does not recite the "discarding said current version of said patient's

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medical history without creating a file copy." Official Notice is taken that using temporary records for a short period of time and deleting them when no longer needed is a well-known and common practice for the security and privacy of the information. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to discard the currently viewable patient record without saving it because it preserves the patient's privacy and prevents unauthorized access to the information.

Claim 97: Schrier et al. teaches a "computerized prescription system" in which the individual prescriber's information is included in the record (col. 21, line 41). However, Schrier et al. does not recite the inclusion of prescriber "contact information" stored on the user computer. Official Notice is taken that maintaining a record of the prescribing practitioner and the practitioner's contact information is old and well-known in the pharmaceutical industry. It is well-known that written prescriptions have historically contained information on the practitioner (name, address, and telephone) and that this information is put into pharmacy databases when creating the prescription for the patient. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include prescriber contact information in the user computer system. The contact information is important to the user so that discrepancies can be addressed, prescriptions re-filled, and other problems remedied with the assistance of the prescribing practitioner.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Two additional US patents are provided: Myers et al. (5,832,450) shows an electronic medical records system with a graphical user interface (see fig. 2a). Rensimer et al (5,845,253) shows a hand held apparatus used in patient monitoring, physician care procedures, and record keeping (see fig. 1 and col. 3).

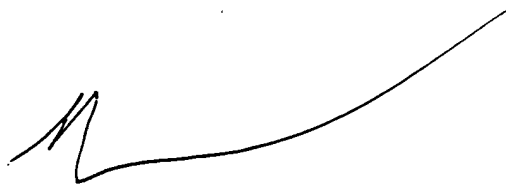
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Crecca whose telephone number is (703) 305-0438. The examiner can normally be reached Monday – Friday from 7:00 – 4:30, with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached at (703) 305-9708.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Information faxes for this Art Unit can be submitted to (703) 308-5357).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

MSC
Sept. 28, 1999



ALLEN R. MACDONALD
SUPERVISORY PATENT EXAMINE!